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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,705	04/06/2001	Youich Tei	M1971-89	6469

7278 7590 01/27/2004

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EXAMINER

BOYKIN, TERRESSA M

ART UNIT PAPER NUMBER

1711

DATE MAILED: 01/27/2004

*R*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/828,705

Applicant(s)

TEI ET AL.

Examiner

Terressa M. Boykin

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2-11-03 I.D.S.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) ☐ Other: \_\_\_\_\_

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 51-148771 as submitted by applicants or JP 405-093079 as submitted by applicants.

**JP405093079** discloses a method to remove foreign matters attached to the surface of molded articles without damaging surface appearance of molded articles by using a specific pretreating agent and to carry out pretreatment of providing the subject molded articles having excellent adhesivity of coating, etc. The method consist of the pretreatment of the surface of molded articles of thermosetting norbornene-based polymer is carried out by using a mixture of (A) 10 pts.wt. aliphatic lower alcohol (preferably ethanol having 12.8 solubility parameter or propanol having 12.00 solubility parameter) and (B) 1-10 pts.wt. readily volatile solvent (preferably toluene or xylene) having 7.0-9.5 solubility parameter as a pretreating agent.

**JP 51-148771** discloses the treatment of norbornene polymers prior to plating - by soaking in alcohols opt. containing. water or other solvents. The starting material is at least one ring-broken polymer or copolymer from (a) ring-broken single polymers of norbornene derivative containing at least one cyano radical or substituted containing. cyano radicals (b) ring-open copolymers comprising at least two compounds. from the

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norbornene derivatives. and (c) ring-open copolymers comprising at least 50 mol. % of the norbornene derivatives. and copolymerising unsaturated cyclic compounds. The material is soaked in (1) at least one alcohol from methanol, ethanol, n-propanol and isopropanol, (2) aqueous. solutions. containing. at least 70 vol. % of the alcohols or (3) mixed solutions comprising at least 80 vol. % of the alcohols and below 20 vol. % of other solvents.


Each of the references discloses a method for purifying a thermoplastic norbornene resin comprising the same components as claimed by applicants.

In view of the above, there appears to be no significant difference between the reference(s) and that, which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

**Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Terressa Boykin, via the receptionist whose telephone number is (703) 308-2351. The examiner can normally be reached on Monday through Friday from 8:00a.m.-5:30 p.m.

tmb

  
Examiner Terressa Boykin  
Primary Examiner  
Art Unit 1711